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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,471

04/29/2005

Toshio Yamagiwa

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04/23/2009

CARRIER BLACKMAN AND ASSOCIATES

24101 NOVI ROAD

SUITE 100

NOVI, MI 48375

EXAMINER

LAI, ANNE VIET NGA

ART UNIT

PAPER NUMBER

2612

NOTIFICATION DATE

DELIVERY MODE

04/23/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/533,471	Applicant(s) YAMAGIWA, TOSHIO	
	Examiner ANNE V. LAI	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-16,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-16, 20-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3, 5-16, 20-21 are currently pending in this case.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed limitation “the IC tag and the database are updated continuously” is not disclosed in the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1, 3, 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamai** in view of **Vock et al** or **Didomenico et al** (all previously provided) and further in view of **Shimura** [US 6,547,128] or **Lauffenburger et al** [US 4,794,470]

In claim 1, **Tamai** discloses an IC tag equipped motorcycle comprising:

an element formed of a resin material having transmissivity to electromagnetic waves; and

an IC tag integrated with the element including an ID code registered therein; the IC tag comprises elements as claimed (figs. 15-16; Construction of Radio IC tag, col. 17, col. 22; motorcycle, col. 34, l. 2).

Tamai does not specify location of the IC tag on the motorcycle. **Vock et al** teach an IC tag can be attached to any object, for example a motorcycle, and at any location of choice on the motorcycle. The IC tag of Vock et al is housed in a case of a meter unit (a Movement Monitoring device MMD 10 and an Event Monitoring device EMD 10 include RFID tags and accelerometer or other sensors). See **Vock et al**, Abstract and Summary of the invention; an MMD containing an IC tag is placed behind the bicycle seat in fig. 21, an MMD placed on the bicycle frame in fig. 41; the Monitoring device housing is made from injection molded urethane plastic, paragraphs 213, 272-285.

Didomenico et al teaches a transponder tag can be affixed to a vehicle at various locations of choice, on the dashboard or integrated within a vehicle part, col. 9, l. 8-24.

Shimura teaches affixing a transponder tag 10 on an odometer inside a case with cover (2, 3). The transponder transmits vehicle ID and measuring data in response to an interrogation from a remote unit. See col. 3, l. 12-53 and figs. 1-3.

Lauffenburger et al [US 4,794,470] (abstract) teaches attaching an electronic tag to an inner surface of the housing of a device during its manufacture.

See also:

Eisenberg et al [US 2002/0196126] teaches inserting an RFID tag into an item during its manufacture (par. 41).

Brandt [US 6,816,083] teaches affixing a RFID module to the inner surface of the cover of an electronic device (col. 3, l. 2-3).

Koch et al [US 6,030,478] teaches inserting a tag assembly into the housing cavity of the rubber patch.

Based on the teaching of the cited references above, an ordinary skill in the art could place the IC tag at any place on the vehicle as preferred for best communication or measuring function.

In claim 3, **Didomenico et al** teaches a transponder tag can be affixed to a vehicle at various locations of choice, on the dashboard or integrated within a vehicle part, col. 9, l. 8-24; **Lauffenburger et al** teaches attaching an electronic tag to an inner surface of a device housing during its manufacture (abstract). It would have been obvious attaching an IC tag on a back surface of a meter panel could be one of a choice for protecting the tag from being damage.

In claim 5, Tamai discloses the tag is molded in resin.

In claim 6, Vock et al teaches the IC tag is embedded in a plastic case of a monitoring device.

In claims 7-15, Tamai discloses memory unit 216 has an unprotected unit (rewritable) 301 and a protected unit 302. The unprotected unit comprising areas for storing activities regarding manufacturing stage, distribution stage, sale stage, service

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stage, collection/recycling stage (col. 17, l. 50 col. 18, l. 46, col. 33, l. 19-col. 36, l. 18), therefore the claimed invention would have been obvious.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamai combined of claim 1 in view of **Takashima** [US 6,352,045] (previously provided).

In claim 16, Tamai does not specify the claimed element disposed near a steering handle of the motorcycle. Didomenico et al teaches a transponder tag can be affixed to a vehicle at any location of choice col. 9, l. 8-24. Vock et al teaches a smart sensor in the form of adhesive bandage to stick to objects of people of choice (abstract). **Takashima** teaches a transponder tag 58 embedded in a resin material and engaged in a mounting portion 64 near the handlebar of a watercraft motorcycle (col. 4, l. 7-65). It would have been obvious an IC tag could be attached to an object at any place of choice for best communication and protection of the tag.

6. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamai** in view of **Vock et al** (all previously provided) and further in view of **Michael et al** [US 2003/0088442] and **Berquist et al** [US 2002/0185532].

In claims 20-21, **Tamai** discloses a management system using an IC tag equipped motorcycle comprising:

a host server 60, a terminal 30a-30e (mobile phone, portable terminal, management device) communicates with each other via a network (Internet 30), and a database 61 (fig. 5);

the terminal 30a-30e comprising devices for wireless reading the motorcycle ID, transmitting the ID and authorized access ID to the host server, receiving and updating information from and to the host server;

the host server 60 comprising devices for verifying authorized access ID, searching database to extract selected tag information, transmitting information to the terminal, receiving tag information and updating tag information to the database;

the IC tag is integrated with an element formed of a resin material that could dispose behind a seat of the motorcycle (see **Vock et al** in the rejection claim 1 above);

the IC tag comprising a CPU, an antenna, a controller, a modem, a memory including write protected areas and rewritable areas.

See **Tamai** figures 4-5 and related specifications.

See **Vock et al**, Summary of the invention; figures 1, 1A, 21 and 41 and related specifications.

See also **Calandruccio** (previously provided), figures 1 and 2 for ID transponder (5, 9) under a seat frame (11, 13) or under a steering handle frame (7, 11).

See also **Hawes et al** [US 5,838,233], for passive RFID tag inside a seat (col. 1, l. 22-34).

Tamai discloses a plurality of management subsystem (20a-20e, fig. 4); each comprises a database subsystem for updating information. Each management subsystem has its own data controller for managing tag information. Although not specified, data updated from one subsystem is preferred to update immediately to other system for effective management. For example **Michael et al** teach an inventory

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management system where main database and local database updates are synchronized (par. 116). **Berquist et al** teach an inventory database may be updated either continuously or periodically (par. 37).

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3, 5-16, 20-21 have been considered but are moot in view of the new ground(s) of rejection.

8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamagiwa [US 7,152,779]; Harada et al [US 7,503,506].

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNE V. LAI whose telephone number is (571)272-2974. The examiner can normally be reached on 9:00 am to 6:30 pm, Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wu Daniel can be reached on 571-272-2964, or primary examiner Davetta Goins at 571-272-2957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/AVL/

/Davetta W. Goins/
Primary Examiner, Art Unit 2612